

REV. 10/96

For Other Than A Small Entity

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. LT-5 Reissue

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GROUP 2100

Anticipated Classification  
of this application:  
Class 323 Subclass 285

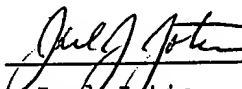
Prior application:  
Examiner S. Riley  
Art Unit 2111

EXPRESS MAIL CERTIFICATION

"Express Mail" mailing label number EF056113391US.

Date of Deposit: December 10, 1996.

I hereby certify that this transmittal letter and the other papers and fees identified in this transmittal letter as being transmitted herewith are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and are addressed to the Hon. Assistant Commissioner for Patents, Box FWC, Washington, D.C. 20231.

  
Joel Jotie

Hon. Assistant Commissioner  
for Patents  
Box FWC  
Washington, D.C. 20231

REQUEST FOR FILING A RULE 62  
CONTINUING APPLICATION

Sir:

This is a request for filing a [X] continuation,  
[ ] divisional, application under 37 C.F.R. § 1.62, of pending  
prior application Serial No. 08/558,204 filed on November 16,  
1995 of Carl T. Nelson for Switching Voltage Regulator Circuit.

1. [ ] Please enter the Amendment pursuant to 37 C.F.R.  
§ 1.116 filed \_\_\_\_\_ in Application Serial  
No. \_\_\_\_\_.
2. [ ] Cancel in this application original claims \_\_\_\_\_  
\_\_\_\_\_ of the prior application before  
calculating the filing fee.

3. ☒ The filing fee is calculated below:

CLAIMS AS FILED IN THE PRIOR APPLICATION,  
LESS ANY CLAIMS CANCELED IN PARAGRAPH 2

FOR	NUMBER FILED	NUMBER EXTRA	RATE	FEE
BASIC FEE				\$ 770.00
TOTAL CLAIMS	91	- 20 = 71	X \$22 =	\$1,562.00
INDEPENDENT CLAIMS	20	- 3 = 17	X \$80 =	\$1,360.00
[ ] MULTIPLE DEPENDENT CLAIMS			+ \$260 =	\$
TOTAL				<u>\$3,692.00</u>

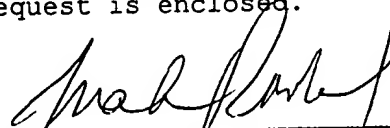
4. ☒ A check in the amount of \$3,692.00 is enclosed.
- 4a. ☐ This application is being filed unaccompanied by a filing fee. The appropriate filing fee will be paid in response to a Notice to File Missing Parts, pursuant to 37 C.F.R. § 1.53(d).
5. ☒ The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 C.F.R. § 1.16, or to credit any overpayment of same to Deposit Account No. 06-1075. A duplicate copy of this Request is enclosed.
6. ☐ Please charge \$\_\_\_\_\_ to Deposit Account No. 06-1075 in payment of the filing fee. A duplicate copy of this Request is enclosed.
7. ☒ Amend the specification by inserting before the first line the sentence: -- This is a  
[X] continuation of application Serial No. 08/558,204, filed November 16, 1995, which is a continuation of application Serial No. 07/683,549, filed April 10, 1991, entitled Switching Voltage Regulator Circuit.
8. ☒ Transfer the drawings from the prior application to this application and abandon said prior application as of the filing date accorded this application. A duplicate copy of this sheet is enclosed for filing in the prior application file.
9. ☐ New formal drawings are enclosed.
10. ☐ Informal drawings are enclosed to expedite prosecution of this application. Formal drawings

will be filed during the pendency of this application.

11. ☐ Priority of application Serial No. \_\_\_\_\_  
filed on \_\_\_\_\_ in \_\_\_\_\_  
\_\_\_\_\_ is claimed under 35 U.S.C. § 119.
- a. ☐ The certified copy has been filed in prior  
application Serial No. \_\_\_\_\_, filed \_\_\_\_\_.
- b. ☐ The certified copy is enclosed.
12. ☒ The prior Application Serial No. 07/683,549 filed  
April 10, 1991, is assigned of record to Linear  
Technology Corporation, Milpitas, California.
13. ☒ The power of attorney in prior Application Serial  
No. 07/683,549 is to:
- Laurence S. Rogers, Reg. No. 28,465  
Mark D. Rowland, Reg. No. 32,077  
Robert W. Morris, Reg. No. 36,613
- a. ☒ The power appears in the papers in the prior  
application.
- b. ☐ Because the power does not appear in the  
original papers, a copy of the power in the  
prior application is enclosed.
- c. ☐ Because the undersigned's power does not  
appear in original papers, a copy of the  
undersigned's power in the prior application  
is enclosed.
14. ☒ Address all future communications to:
- Mark D. Rowland  
Reg. No. 32,077
- c/o FISH & NEAVE  
1251 Avenue of the Americas  
New York, New York 100200-1104  
Tel.: (415) 617-4000
15. ☐ A preliminary amendment is enclosed.
16. ☒ Please grant ☐ a one-month, ☐ two-month,  
☒ three-month, ☐ four-month, extension of  
time under 37 C.F.R. § 1.136 to the official  
action of June 11, 1996 in Application Serial No.  
08/558,204, filed November 16, 1995, so that this  
Request will be filed while that application is  
still pending.

17. ☒ A check in the amount of \$930.00 in payment of the extension-of-time fee is enclosed.
18. ☒ The Commissioner is hereby authorized to charge payment of any additional extension-of-time fees required under 37 C.F.R. § 1.136, in connection with this paper, or to credit overpayment of same, to Deposit Account No. 06-1075. A duplicate copy of this Request is enclosed.
19. ☐ Please charge the extension-of-time fee of \$\_\_\_\_\_ to Deposit Account No. 06-1075. A duplicate copy of this Request is enclosed.

December 9, 1996

  
\_\_\_\_\_  
Mark D. Rowland  
Registration No. 32,077

c/o FISH & NEAVE  
1251 Avenue of the Americas  
New York, New York 10020-1104  
Tel.: (415) 617-4000

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APPLICATION FOR REISSUE  
OF U.S. PATENT 4,823,070

Date of Issue : April 18, 1989  
Inventor : Carl T. Nelson  
Title : SWITCHING VOLTAGE REGULATOR  
CIRCUIT  
Assignee : Linear Technology Corporation  
Reissue Serial No. : 08/558,204  
Reissue Filing Date : November 16, 1995  
Examiner : S. Riley, Art Unit 2114

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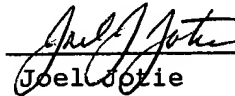
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Joel L. Jolie

Hon. Assistant Commissioner  
for Patents  
Box FWC  
Washington, D.C. 20231

Mar 28 1997  
SAFE BMS

REQUEST FOR SUSPENSION OF ACTION IN REISSUE  
APPLICATION IN VIEW OF CONCURRENT LITIGATION

This reissue proceeding is directed to U.S. patent 4,823,070 (the "'070 patent"). This proceeding was initiated based on reissue application Serial No. 07/683,649, filed April 10, 1991, which is the parent of the present reissue application Serial No. 08/558,204. For reasons discussed below, the

action in the reissue proceeding pursuant to MPEP § 1442.02 in view of concurrent litigation involving "on sale" bar issues that overlap with issues in this reissue proceeding.\*

As was stated by the named inventor of the '070 patent, Carl T. Nelson, in his Reissue Declaration And Power Of Attorney dated April 5, 1991, the invention disclosed in the '070 patent was incorporated into a five-terminal current-mode switching voltage regulator integrated circuit product sold by the assignee of the '070 patent, Linear Technology Corporation ("LTC"), under the designation of "LT-1070." (See ¶ 6 of the Reissue Declaration And Power Of Attorney filed in the '649 reissue application).

In addition to the invention of the '070 patent, LTC's LT-1070 product includes an invention claimed in U.S. patent 4,775,741 (the "'741 patent"), entitled "Adaptive Transistor Drive Circuit." The '741 patent, like the '070 patent, is assigned to LTC, and both have a filing date of November 18, 1986.

During prosecution of the '070 and '741 patents, the applicant submitted declarations of LTC employees Nello Sevastopoulos, Derrick Berry, Hans J. Zapf and Robert C. Scott setting forth facts relating to LTC's LT-1070 product. These declarations established that the LT-1070 was not in public use or on sale in this country more than one year prior to the November 18, 1986 filing date of the applications for the '070 and '741 patents. Subsequently, during prosecution of the application to reissue the '070 patent, and in connection with a

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\* Concurrently herewith, the applicant is filing a request to file a Rule 62 Continuation of the present reissue application Serial No. 08/558,204. The applicant respectfully requests that the suspension of action apply to the Rule 62 continuation application.

declaration of another of its employees, Daniel W. Wark, which particularly concerned certain sales-related documents that were discovered at an LTC warehouse. This declaration also established that the LT-1070 was not on sale in this country more than one year prior to the filing date of the applications for the '070 and '741 patents.

In May 1994, LTC commenced a lawsuit against Micrel, Inc., in the United States District Court for the Northern District of California, Case No. C94-1633 EFL ("the Litigation"), alleging among other things that Micrel was infringing the '741 patent.

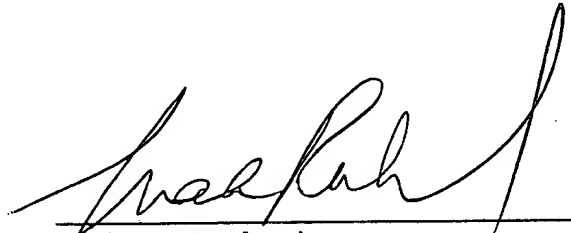
In response to LTC's charge of patent infringement, Micrel raised various defenses in the Litigation. One defense raised by Micrel was that LTC's LT-1070 product was on sale in this country more than one year prior to the November 18, 1986 filing date of the application for the '741 patent, thus invalidating the '741 patent under 35 USC § 102(b). Micrel also raised a defense that the '741 patent is unenforceable because LTC allegedly withheld material information from the Patent Office relating to the alleged "on sale" bar, with intent to mislead, thus fraudulently obtaining the '741 patent.

LTC denied Micrel's assertions that the '741 patent is invalid and unenforceable. Although discovery in the Litigation relating to the '741 patent was stayed in whole or in part in 1994 and 1995, since January 1996 the parties have engaged in discovery relating to all issues, including Micrel's on sale contentions, and Linear Technology expects this discovery to continue until at least January 1997. The Court is currently scheduled to hear a motion for summary judgment relating to

The on sale issue currently being addressed in the Litigation, and Micrel's related allegations of invalidity and unenforceability as to the '741 patent, overlap with the present reissue application because the invention of the '070 patent now in reissue is embodied in the same LTC LT-1070 product that Micrel contends was on sale more than one year prior to November 18, 1986 - the common filing dates of the '070 and '741 patents. Accordingly, if the Court finds that a statutory on sale bar does not exist as to the '741 patent, the same facts would support a finding that a statutory on sale bar does not exist as to the '070 patent as well. Similarly, if the Court finds that a statutory on sale bar does exist as to the '741 patent, the same facts would support a finding that a statutory on sale bar also exists as to the '070 patent.

In view of this concurrent litigation, and in order to avoid duplication of effort between the Litigation and this reissue proceeding, applicant respectfully requests that action in this reissue application be stayed until termination of the Litigation.

December 9, 1996



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